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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/522,125

01/24/2005

Andreas Bacher

WAS0676PUSA

1954

22045 7590 09/21/2007

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EXAMINER

EGWIM, KELECHI CHIDI

ART UNIT

PAPER NUMBER

1713

MAIL DATE

DELIVERY MODE

09/21/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/522,125	<b>Applicant(s)</b> BACHER ET AL.	
	<b>Examiner</b> Dr. Kelechi C. Egwim	<b>Art Unit</b> 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 14-27 is/are pending in the application.
- 4a) Of the above claim(s) 14-17 and 23-27 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18-22 is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's affirmation of the election with traverse of Group II, claims 18-22, in the reply filed on 07/02/2007 is acknowledged. The traversal is on the ground(s) that "product-by-process claims 14 - 17 contain all the limitations of elected process claims 18 - 22, and thus if the latter claims are allowable, rejoinder of the product claims is mandatory under MPEP §821.04."

This argument is not persuasive as applicant is incorrect in the first instance. The elected claims are to a process. The nonelected claims are to products. Even though the product-by-process claims may recite a process which MAY be used to prepared the product, these claims are still ONLY to the product. Thus, the claims to the product DO NOT REQUIRE the process of claims 18-22.

Applicant also traverses by arguing that "[t]he basis for lack of unity of invention in this National Stage of a PCT application is lack of a common technical feature". This is inaccurate. It is not the lack of a "common technical feature" as argues by applicant, but rather lack of the common technical feature that, itself, represents a contribution to the art, i.e., a common **special** technical feature.

Regarding the argument that "unity of invention has already been addressed by the PCT Examining Authority", a finding of lack of unity is proper and can be found during any stage of prosecution, including the National stage. In any regard, these claims were not presented during the International stage of prosecution.

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Regarding the contribution to the art of the silane modified polyvinyl alcohol/acetal, the common technical feature, applicant is directed to US 4,739,021.

The requirement is still deemed proper and is therefore made FINAL.

2. This application is in condition for allowance except for the presence of claims 14-17 and 23-27, directed to inventions non-elected with traverse, affirmed in the reply filed on 07/02/2007. Applicant is given ONE MONTH or THIRTY DAYS from the date of this letter, whichever is longer, to cancel the noted claims or take other appropriate action (37 CFR 1.144). Failure to take action during this period will be treated as authorization to cancel the noted claims by Examiner's Amendment and pass the case to issue. Extensions of time under 37 CFR 1.136(a) will not be permitted since this application will be passed to issue.

The prosecution of this case is closed except for consideration of the above matter.

***Allowable Subject Matter***

3. Claims 18-22 are allowable.

4. The following is a statement of reasons for the indication of allowable subject matter: While prior art such as Harris, Jr. USPN 4,739,021. teach silane modified polyvinyl alcohol with aldehyde functionalized in the silane moieties, they do not teach the process of forming the polymer in the single step of polymerizing the monomers in

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the presence of the silane functional aldehyde or acetal compounds, followed by hydrolyzing the polymers.

Other prior art such as US 4,097,436 and EP 322175 teach polymerizing the vinyl ester monomers in the presence of silane compounds or aldehydes or acetal compounds, however, none of the prior art was found to teach or sufficiently suggest, a process for preparing silane-containing polyvinyl alcohols and acetals by free-radically polymerizing vinyl esters of 1 to 18 carbon alkylcarboxylic acids in the presence of silane-containing aldehydes or acetals, and hydrolyzing the vinyl ester polymers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (571) 272-1099. The examiner can normally be reached on M-T (7:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KELECHI C. EGWIM PH.D.  
PRIMARY EXAMINER

KCE

